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IRVING, TX 75062

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| EXAMINER |
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STRANGE, AARON N

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2153

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09/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/782,412

Applicant(s)

MOUSSEAU ET AL.

Examiner

Aaron Strange

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

### ***Response to Arguments***

2. Applicant's arguments filed 7/10/07 have been fully considered but they are not persuasive.
3. With regard to independent claims 65, 89, 97 and 108, and Applicant's assertion that "only by improperly re-characterizing the term 'non-qualifying message' of Eggleston to mean all messages, can one show the alleged equivalency required for anticipation" (Remarks, 29), the Examiner respectfully disagrees.

As an initial matter, it is noted that the current claims contain no language requiring "all messages" (at least all messages containing an attachment) to be processed in a particular way. The claims refer to operations performed on a single message that contains an attachment, and do not contain any language suggesting that all messages containing an attachment are processed in the claimed manner, only that the particularly claimed data item is processed according to the claimed steps. Based on Applicant's remarks, it appears that Applicant agrees that the required operations are performed on at least one "non-qualifying message" in Eggleston, but asserts that these operations are not performed on "qualifying messages" (Remarks, 24-29).

Since Eggleston's "non-qualifying messages" are e-mail messages containing attachments, and are processed using each of the claimed steps, Eggleston anticipates claims 65, 89, 97, and 108. The mere fact that it processes additional messages in a different manner does not erase Eggleston's teachings regarding the non-qualifying messages.

4. Furthermore, in the interest of expedited prosecution, the Examiner would like to note that even amending the present claims to require all messages received by a device to be processed using the claimed steps would not place the application in condition for allowance. Eggleston discloses that the filtering criteria may be set by the user (col. 2, ll. 66-67) and may be configured as desired by the user to allow/prevent transmission of particular messages (col. 8, ll. 14-55). Configuring these rules in a manner (i.e., setting the maximum attachment size to zero) which would trap all messages containing an attachment in a filter (causing them to be "non-qualifying") would have been obvious to one of ordinary skill in the art who wished to manually retrieve attachments from the server. The benefits of doing so, such as reducing the cost associated with receiving messages over the network (Eggleston, col. 3, ll. 12-15), would have been apparent to one of ordinary skill in the art.

5. With regard to claims 66, 71-88, 90, 91-96, 98, 100-107, 109 and 111-118, Applicant has not presented any substantive arguments directed toward the rejection of these claims, essentially relying on the traversal of Eggleston addressed above. Since

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Applicant's arguments with respect to claims 65, 89, 97 and 108 are not persuasive, Applicant's incorporation of those arguments here is unpersuasive as well.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 65, 67-70, 89, 91a, 97, 99, 108, and 110 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al. (U.S. Patent Number 5,958,006; hereinafter Eggleston).**

8. With regard to claims 65, 89, 97, and 108, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith via a wireless gateway, the method comprising the steps of:

Receiving a data item (email) at the host system (server 115) from a message sender, the data item being directed to an address associated with the user at the host

system (address of mobile user 105), the data item including an e-mail message and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

Redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via the wireless gateway using a network address of the mobile data communication device (e.g. when the user has implemented a filter and only part of the message is sent to the user, see inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

Receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Redirecting the message attachment from the host system to the mobile data communication device via the wireless gateway using the network address of the mobile data communication device in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

9. With regard to claims 67, Eggleston disclosed:

Configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

10. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

11. With regard to claims 70, 99, and 110 Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**13. Claims 66, 71-88, 90, 91, 92-96, 98, 100-107, 109, and 111-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (U.S. Patent Number 5,958,006; hereinafter Eggleston) and Kikinis (U.S. Patent Number 5,964,833).**

14. With regard to claims 74, 79, 103, and 114, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith via a wireless gateway, the method comprising the steps of:

Receiving a data item (email) at the host system (server 115) from a message sender, the data item being directed to an address associated with the user at the host system (address of mobile user 105), the data item including an e-mail message and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

Redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via the wireless gateway using a network address of the mobile data communication device (e.g. when the user has implemented a filter and only part of the message is sent to the user, seen inter alia Col 3, lines 23-26 and Col 10, lines 10-32);



Receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Redirecting the message attachment from the host system to the mobile data communication device via the wireless gateway using the network address of the mobile data communication device in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Eggleston disclosed substantial features of the claimed invention including providing typical email functions to mobile users (e.g. compose, reply, and forward). However, Eggleston failed to specifically recite receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device and redirecting the message attachment from the host system to the external device in response to the second command message. Nonetheless such functionality would occur when a user forwarded an email message containing an email attachment to another mobile user, as would typically occur during email use. The claimed second command is equated with the user's forward command (i.e. user decides forward an email with an attachment) that is sent to the server and the claimed external device is equated the intended mobile recipient of the forwarded message including the attachment. The user would typically perform such a forwarding

function in order to convey pertinent information contained in an email or email attachment to another mobile user.

Thus, it would have been obvious to a user of ordinary skill in the art at the time of Applicant's invention to utilize the traditional email forwarding command in Eggleston's system to forward an email containing an attachment to another mobile user, in order to convey information to other users. Again such a traditional email forward command would naturally result in receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device and redirecting the message attachment from the host system to the external device in response to the second command message.

Furthermore it was widely known in the art at the time of Applicant's invention to forward email attachments to external devices other than e-mail recipient devices, as evidenced by at least Kikinis. In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that users can

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communicate with other people by using different means rather than just email and thus communicate with more people.

15. With regard to claim 66, Kikinis disclosed providing a user profile for the mobile data communication device, wherein the user profile stores a list of one or more external device associated with the mobile data communication device (i.e. preprogrammed external devices such as a fax machine, Kikinis Col 4, lines 50-56).

16. With regard to claims 71, Examiner takes official notice that word processing files, audio files, and video files, were all widely known types of files to save and transfer information at the time of Applicant's invention. Furthermore it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention so send these types of files as attachments in order to transfer information between users.

17. With regard to claims 72 and 73, Examiner takes official notice that word processing files often could be processed (i.e. displayed) by mobile devices such as the mobile station MS of Eggleston's system and further video files often could not be processed by mobile devices due to their constrained resources. Thus, in view of the official notice taken in claim 71, the message attachment could be a file type that the mobile communication device can process (e.g. word processing file) and could also be an attachment that the mobile communication device cannot process (e.g. video file).

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18. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

19. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

20. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

21. The remaining dependent claims are rejected using a similar rationale as applied to the above claims.

### ***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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